

U.S. Patent Application No. 10,767,536
Office Action dated: April 8, 2005
ATTORNEY DOCKET NO. ELTE 02894 PTUS

AMENDMENTS TO THE DRAWINGS

Substitute drawings are attached, which include all reference numerals.

REMARKS

AMENDMENTS TO THE DRAWINGS

The drawings are objected to as failing to comply with CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description. Applicants have now included reference numerals in the drawings and respectfully request that the objections to the drawings be withdrawn.

REMARKS RESPONSIVE TO THE OFFICE ACTION

Claims 1-7 are pending, and Claims 1-7 have been amended in this Response. Reconsideration and allowance are respectfully requested in light of the above amendments and following remarks.

1. CLAIM OBJECTIONS

Claims 1-7 are objected to because of the following informalities: The preamble in claim 1 should read –An auxiliary eyewear display mount--; otherwise, there is no means to provide the function of displaying. The preamble in the dependent claims 2-7 should be the same as the independent claim to which claims 2-7 depend from. Appropriate correction is required.

1. APPLICANTS' RESPONSE

Claims 1-7 are objected to as containing informalities. Specifically, the Examiner asserts that the preamble of Claim 1 should read: An auxiliary eyewear display mount. Claim 1 has been amended to correct this informality, and dependent Claims 2-7 have been amended for the sake of continuity with Claim 1. However, Applicants contend that the rationale underlying this amendment bears no

more than a tangential relation to any equivalence in question because the preambles were simply amended for the sake of clarity. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S.Ct. 1831 (2002).

2. CLAIM REJECTIONS – 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action.

A person shall be entitled to a patent unless—

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Ennis (5,069,416).

The limitations in claims 1, 3 can read on the Ennis's Figs. 1-4, column 2. Ennis discloses an eyewear display mount comprising a clamp 4, an arm extension 6 and a cradle 12 wherein the cradle comprising a relief between flange 18 and the outer flange 18.

2. APPLICANTS' RESPONSE

Claims 1 and 3 stand rejected under 35 U.S.C. §102(b) in view of U.S. Patent No. 5,069,416 by Ennis ("Ennis"). Insofar as they may be applied against the Claims, these rejections are traversed.

According to MPEP § 2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Specifically, Ennis does not disclose a bridge clamp. The Examiner on page 3 of the Office Action indicates that "clamp 4" is the bridge clamp; however, it can clearly be seen from FIGURE 1 that clamp 4 engages vertical rod 2, which is "made of acrylic or the like" (col. 2, lines 11-12). In contrast, the present invention of Claim 1 employs a clamp that

couples to the primary bridge such that a pair of auxiliary lenses can be cradled therefrom, as shown in FIGURES 1 and 2 of the above-reference Application.

In view of the foregoing, it is apparent that the cited reference does not disclose, teach or suggest the unique combination recited in Claim 1. Applicants therefore submit that Claim 1 is clearly and precisely distinguishable over the cited reference in a patentable sense, and is therefore allowable over this reference. Accordingly, Applicants respectfully request that the rejection of Claim 1 under 35 U.S.C. § 102(b) in view of Ennis be withdrawn.

Claim 3 depends on and further limits Claim 1. Hence, for at least the aforementioned reasons, Applicants respectfully request that the rejection of Claim 3 under 35 U.S.C. § 102(b) in view of Ennis be withdrawn.

3. CLAIM REJECTIONS – 35 USC § 102

Claims 1 and 4 are rejected under 35 USC 102(b) as being anticipated by Nespoli (5,082,225).

The limitations in claim 1 can read on Nespoli' s Figs. 1-3. Nespoli discloses an eyewear display mount 1 comprising a clamp 2, an arm extension and a cradle wherein the cradle comprising a relief between the inner flange 5 and the outer flange 6.

Regarding claim 4, the display mount is made of a pliant material or compressible material.

3. APPLICANTS' RESPONSE

Claims 1 and 4 stand rejected under 35 U.S.C. §102(b) in view of U.S. Patent No. 5,082,225 by Nespoli ("Nespoli"). Insofar as they may be applied against the Claims, these rejections are traversed.

Rejected independent Claim 1 as now amended more particularly recites one of the distinguishing characteristics of the present invention, namely, "a bridge

clamp for a first lens assembly [and] a second lens assembly cradle." (Emphasis added.) Support for this Amendment can be found, among other places, at paragraph [0034] of the original Application.

Specifically, Nespoli does not teach, disclose, or suggest a cradle for auxiliary eyewear. Instead, Nespoli discloses an apparatus that clamps to a sunvisor 11 that supports and protects a pair of sunglasses (primary eyewear). Nowhere is there even a suggestion that the apparatus of Nespoli is or can be used to display auxiliary eyewear in combination with primary eyewear as can be seen in FIGURES 1 and 2 of the present Application. Thus, the present invention of Claim 1 would allow one to display both primary and auxiliary eyewear in close proximity to one another, which Nespoli does not provide.

In view of the foregoing, it is apparent that the cited reference does not disclose, teach or suggest the unique combination recited in Claim 1. Applicants therefore submit that Claim 1 is clearly and precisely distinguishable over the cited reference in a patentable sense, and is therefore allowable over this reference. Accordingly, Applicants respectfully request that the rejection of Claim 1 under 35 U.S.C. § 102(b) in view of Nespoli be withdrawn.

Moreover, Claim 4 depends on and further limits Claim 1. Hence, for at least the aforementioned reasons, Applicants respectfully request that the rejection of Claim 4 under 35 U.S.C. § 102(b) in view of Ennis be withdrawn.

4. CLAIM REJECTIONS – 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 103(a) that form the basis for the rejections under this section made in this Office Action.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention is made.

Claims 2, 5-7 are rejected under 35 USC 103(a) as being unpatentable over

Ennis in view of Rodriguez (5,864,924).

Ennis discloses the claimed invention as discussed above, however the clamp does not have the structure of a base, a pivot pin, a lever and a spring member whereas the spring member urges the lever against the base as claimed in claims 2, 5-7. A clamp including a base, a pivot pin, a lever and a spring member for urging the lever against the base is called conventional clamp and well known in the art as taught by Rodriguez, for example for the purposes of clamping an article between the base and the lever. Since Ennis and Rodriguez are both from the same field of endeavor, the purpose disclosed by Rodriguez would have been recognized in the pertinent art of Ennis. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the Ennis's device in light of Rodriguez's teaching by forming a clamp including a base, a pivot pin, a lever and a spring member for urging the lever against the base, as a conventional clamp for the purpose of clamping an article between the base and the lever disclosed by Rodriguez as the same as the applicant does.

4. APPLICANTS' RESPONSE

Claims 2 and 5-7 stand rejected under 35 U.S.C. §103(a) in view of Ennis and U.S. Patent No. 5,864,924 by Rodriguez ("Rodriguez"). Insofar as they may be applied against the Claims, these rejections are respectfully traversed.

Specifically, neither Ennis nor Rodriguez teach, disclose, or suggest a combination of a cradle and clip for supporting a first and a second lens assembly. Instead, each of Ennis and Rodriguez disclose a support for a single lens assembly. More specifically, there is not a teaching, or even mere suggestion, to support a complementary arrangement of a first and a second lens assembly (such as a primary and auxiliary lens assembly) in a single display mount as can be seen in FIGURES 1 and 2 of the present Application. Thus, the present invention of Claim 1 would allow one to display both primary and auxiliary eyewear in close proximity to one another, which Nespoli does not provide. Additionally, because there is no

expressed or implied motivation to combine the references as the Examiner has done, Applicants assert that the Examiner has employed impermissible hindsight reasons.

In view of the foregoing, it is apparent that the cited reference does not disclose, teach or suggest the unique combination recited in Claims 2 and 5-7. Applicants therefore submit that Claims 2 and 5-7 are clearly and precisely distinguishable over the cited reference in a patentable sense, and are therefore allowable over this reference. Accordingly, Applicants respectfully request that the rejection of Claims 2 and 5-7 under 35 U.S.C. § 103(a) in view of Ennis and Rodriguez be withdrawn.

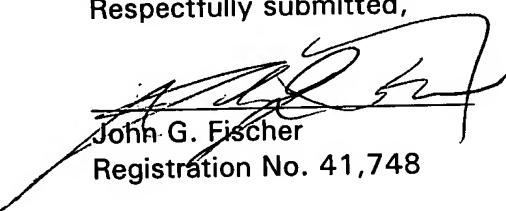
CONCLUSION

Applicants appreciate the Examiner's thorough review of the prior art, and Examiner's remarks related thereto. The Application has been carefully reconsidered in view of the Office Action of April 8, 2005. On the basis of the above amendments and responses, Applicants respectfully submit that the only stated grounds for rejection of Applicants' claims have been addressed and eliminated. Applicants now respectfully assert that the above amendments to the claims and the above responses now place this Application in condition for allowance. Consideration of this Application for early allowance is requested.

Applicants encloses a check in the amount of \$510.00 for the three (3) months extension due; however, in the event that any fees are due, the Commissioner is hereby authorized to charge any required fees due (other than issue fees), and to credit any overpayment made, in connection with the filing of this paper to Deposit Account 50-2180 of Storm LLP.

Should the Examiner require any further clarification to place this Application in condition for allowance, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,



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Date: 9-20-05

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